

RECEIVED  
CENTRAL FAX CENTER

MAR 29 2010

*In the United States Patent and Trademark Office*

Appn. Number: 09/641,410  
Appn. Filed: August 18, 2000  
Applicant: Alice Mary O'Donnell Kiely  
Title: Edible Supports for Comestibles with Optional, Edible Mess Guards and Drip Guards  
Examiner/GAU: Keith Hendricks/Joyti Chawla 1794

Yorktown Heights, NY March 27, 2010

**Petition to Director**

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 CFR 1.181(a)**

Assistant Commissioner for Patents  
Arlington, Virginia 22313

Sir:

Applicant respectfully requests the withdrawal of the holding of abandonment for the application of 09/641,410, Edible Supports for Comestibles with Optional, Edible Mess Guards and Drip Guards.

MAR 29 2010

Appn. Number 09/641,410 (Kiely) GAU 1794 Petition to Director to Withdraw Holding of Abandonment 2

**Petition To Withdraw Holding of Abandonment  
Based on Improper Final Rejection Under 37 CFR 1.181(a)**

This correspondence is in regard to U.S. Patent Application SR Number 09/641,410, Edible Supports for Comestibles with Optional, Edible Mess Guards and Drip Guards. Application 09/641,410 is a parent application to several divisional applications. Patent Application SR No. 09/641,410 was filed August 18, 2000, and is currently pending.

Applicant is in receipt of a final Office Action mailed July 9, 2009, for the above application. Applicants respectfully request that the finality of the Office Action, and thus abandonment should be withdrawn as the Office Action is improper.

Applicant respectfully requests going forward that examiners during examination: 1) address every element of Applicants claims as recited, [emphasis added] 2) properly address Applicant's subject matter of: a) a support for a frozen comestible comprising an edible "composite material," (as originally filed in claims 6, 19, 21-23, which is a term well known to one having ordinary skill in the art), and b) a support for a frozen comestible comprising an edible material, said edible material comprises two materials, and 3) specifically answer the substance of Applicant's arguments.

Applicant respectfully submits that the finality of the Office Action is improper because the Office has failed to address Applicant's claims as recited.

Applicant respectfully submits that the finality of the Office Action is also improper as the Office has failed to address every argument of Applicant under MPEP 707.07(f)

Applicant respectfully submits that the finality of the Office Action is also improper due to the introduction of a new reference in a final Office Action, not necessitated by an amendment of Applicant or an IDS, and therefore requests withdrawal of that finality, according to Section 706.07(a) of the Manual of Patent Examining Procedure (MPEP), which is also in violation of compact prosecution MPEP 707.07(g).

Applicant respectfully submits that the finality of the Office Action is also improper due to the withholding of Applicant's method claims from consideration without any evidence, suggestion, or argument of a patentably distinct species.

Applicant respectfully submits that the finality of the Office Action is further notably improper as Examiner Joyti Chawla had admitted to Applicant in a telephone conversation on January 29, 2010 to basing the rejections of all Applicant's claims on a truncated portion of Applicant's claims, "i.e. two constituent materials." ((Exhibit L, Summary of phone call, below)

Applicant respectfully submits that the finality of the Office Action is further noted to be improper, [emphasis added] as Examiner(s) have sustained all rejections based on willful and erroneous misinterpretation of Applicant's subject matter for years in PTO Office Actions, although the record shows that Examiners are well aware of Applicant's subject matter.

Additionally, Applicant respectfully submits that the finality of the Office Action is improper as Examiner Jyoti Chawla has also admitted to Applicant on the telephone call of January 29, 2010, that Examiner is "not making a 35 USC Section 102 rejection, but a section 103 rejection," yet continues to hold all claims rejected by that single reference under 35 USC Section 102, based solely upon truncating Applicant's claims and without any evidence.

Furthermore, Applicant respectfully submits that the finality of the Office Action is also improper, as while the Office Action(s) agrees that all elements in Applicant's claims are NOT anticipated by a single reference (Office Action admits that the support of the single reference to Musher is *entirely frozen* [Applicant's is non frozen]) the reference has not been withdrawn and continues to be used to hold all claims rejected under section 102, without evidence for many years while on its face does not anticipate Applicant's claims.

#### **Applicant's Disclosure (Background)**

Three Disclosure Documents claiming date of conception of Applicant's supports were filed with the US Patent and Trademark Disclosure Document Program in 1994, 1996, and 1999.

In response to the restriction of 5/2/02, Applicant had elected, wherein the support is a candy bar and filed claims of a support comprising a composite candy. (Exhibit M, top arrow, right side)

In response to the restriction of 12/19/2002, Applicant had elected Species III, wherein the support is a composite support as shown e.g. in Fig. I,

Composite support 62 as shown in Fig. 1:

#### **The specification recites in part:**

[0165] Preferably, support 62 is an elongated and slenderized, multi-ingredient, candy bar (made to a suitable size and shape to support the confection) such as those found at the check-out counter of a grocery store.

[0166] One such candy bar has the ingredients of a whipped chocolate nougat center that is then coated with a thick chocolate coating (barrier 86), sold under the trademark Three Musketeers by Mars, Incorporated of Hackettstown, N.J. Another suitable candy bar that contains the ingredients of a whipped chocolate nougat center 90, topped with a thick layer of caramel 88, which is then totally dipped in a thick chocolate coating 86 (FIG. 27D), is one sold under the

trademark Milky Way, also by Mars, Incorporated. (The ingredients and barrier or chocolate coating 86 are not specifically shown in support 62 in FIGS. 1 and 2, for clarity, but are shown in FIGS. 15A, 27A-E). Another suitable candy bar for an edible support is made with the ingredients of an elongated dense cookie, coated on top with a thick layer of caramel, which is then dipped in a chocolate coating, (FIG. 27B) such as the one sold under the trademark Twix, also by Mars, Incorporated. A frozen Twix candy bar efficiently supports confection 84.

[0167] Other candy bars that are also suitable as edible supports for confection 84, such as the one sold under the trademark, Butterfinger, by Nestle Incorporated, of Glendale, Calif., has the ingredients of ground roasted peanuts, dipped in a thick chocolate coating (and other ingredients) and one sold under the trademark Snickers, also by Nestle, has peanuts, caramel and a chocolate coating. Another candy bar sold under the trademark 100 Grand, also by Nestle, has the ingredients of chewy caramel, milk chocolate and crispy crunchies (FIG. 27C). 100 Grand candy bar, if slenderized, elongated and frozen is an efficient support 62 for confection 84. A candy bar sold under the trademark Baby Ruth, also by Nestle, with the ingredients, peanuts, caramel and nougat, also if slenderized is a rich, edible support for confection 84. Other suitable candy bars are the candy bars sold under the trademarks Mounds and Almond Joy, both by Hershey Foods Corporation, of Hershey, Pennsylvania. These supports may be any size, length, width, shape or thickness. A bite size additional fun ingredient 100, sold under the trademark Nestle Bites also of Nestle Incorporated, which has several flavors, may be added to confection 84 or an edible support for additional enjoyment. These candy bars offer a familiar and desired taste to many people in the United States and to many people of other countries throughout the world.

**End of partial Background**

#### **Grounds**

As grounds for this Request, Applicant states as follows:

In replies to the non-final and final Office Actions, Applicant requested that the finality of the Office Actions not be made final, and then the finality removed, and specified the reasons why the a final Office Action would be improper. (11/23/2009, 25 pgs.; and 10/9/2009, 20 pgs.) Applicant's reasons why the final Office Action would be improper were not addressed in the advisory actions, except for upholding denying Applicant method claims, for which Examiner's reason is incorrect on the record, i.e. PTO Office Actions, below.

#### **Election/Restriction**

##### **1) Regarding Election/restriction:**

Examiner's stated grounds for withholding of Applicant's method claims from examination:

Appn. Number 09/641,410 (Kiely) GAU 1794 Petition to Director to Withdraw Holding of Abandonment 5

"Newly submitted claims 403-416 are directed to a method of making a support, i.e., an invention that is independent or distinct from the invention elected in response filed January 18, 2003 to the original restriction requirement." Since Applicant had elected a product and not the method of making in response to the election requirement the method of making the product, i.e. claims 403-416 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP section 821.03. Thus claims 403-41 will not be examined in the present Office Action.

Examiner has failed to address Applicant's argument that no restriction for a method claim had ever been made. (Exhibit A, pg 1-3, restriction of 5/2/2002); Exhibit B, election of 1/18, 2003); (Exhibit C, pgs. 1/4 - 4/4) (Method claims had also been previously presented on 1/28/2008, 5/16/2008, 7/30/2008, 8/20/2003, 8/18/2000 (date of filing)).

N.B. Contrary to examiner, the first Office Action on the merits did in fact address Applicant's method claims (Exhibit H, pg. 4/5, 5/23/2003): "In regard to method claim 95, since...) No restriction had been made.

An objection to the method claims could have been made at the time of the election requirement on 5/2/2002, (Exhibit A), however Examiner did not object. An objection to the method claims could have been made at the time of the first Office Action on the merits on 5/23/2003, (when they were addressed, (Exhibit H, pg. 4/5), or even the final Office Action of 3/9/2004, or any of the times directly above, however examiner did NOT object. (MPEP 2106 II, "...Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office Action.")

Applicant further argued that as far as Applicant is aware, electing a species does not preclude one from including a method claim(s). Applicant is entitled by right to a method claim(s) MPEP 800, if the claims are not patentably distinct. To continually deny Applicant access to a method claim(s) based solely upon the election of a species, especially when NO restriction had ever been made, and NO reason of the method claims being patentably distinct had ever been stated by examiner, is improper. This argument was not addressed or answered by examiner either.

In the advisory action of 1/28/2010, Examiner stated that a reason for rejection of the method claims is that Applicant's method claims were not present as of the time of the election, and stated that the "claims are directed to a method of making a support, i.e, an invention that is independent or distinct from the invention elected in response filed January 18, 2003 to the original restriction requirement." (Exhibit E - Advisory Action 1/28/2010) Applicant's method claims were present at the time of filing, and these method claims had been addressed by the PTO in the first Office Action on the merits and were not restricted. (Exhibit H, pg. 4/5, above) (Exhibit D - August 18, 2000). Applicant had also argued that as far as Applicant knew, method claims need not be present at the time of a restriction, but only they cannot be patentably distinct. This argument had not been answered. (Applicant's response filed on January 18, 2003 is also not the "original" restriction requirement, as examiner states. See restriction of 5/2/2002)

Examiner had also failed to address Applicant's argument that method claims had been included as originally filed on 8/18/2000 (claims 28, 29(30)) (Exhibit D).

Examiner had also failed to state examiner's burden of proof as to how Applicant's method claims are directed to a non-elected invention. Other than to say:

"Since Applicant had elected a product and not the method of making in response to the election requirement..." or "not present as of the time of the election."

N.B. Examiner has failed to give any reasoning whatsoever as to how Applicant's method claims are directed to a non-elected invention. Applicant argued that Applicant's method claims are generic to the invention being examined and considered proper unless proven otherwise. Failure to show a distinct non-elected invention while withdrawing Applicant's method claims from consideration constitutes an improper Office Action. Applicant respectfully requests examiner state *specifically* how Applicant's method claims constitute a patentably distinct species, or Applicant respectfully requests immediate removal of the withdrawal of Applicant's method claims from consideration, and be properly examined.

#### Amendments to Specification

Examiner states:

"The amendment filed March 16, 2009, is once again objected to under 35 USC 132(a) because it introduces new matter into the disclosure. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In the instant case the term "composite material" as added to the claims introduces new matter as the term is not disclosed in the original disclosure and the introduction of the term "composite material" changes the description of "a candy bar" to "a composite material candy bar" which is not the same as a generic term "candy bar" as originally described."

2) Regarding **Amendment to Specification**, examiner has continually failed to respond to Applicant's argument that the term "composite material" could not be "new matter," when Applicant had shown documentation many many times to examiner that the term "composite material" had been specifically recited in the original disclosure in claims 6, 19, 21-23, filed August 18, 2000. (Exhibit F, pg. 1-3)

Applicant had also made the argument that Applicant is permitted to amend the specification with the term "composite material," as the term was originally filed in at least claims 6, 19, in accordance with MPEP 608.01 (Exhibit G pgs. 1-3). Also Applicant's specification teaches of a "composite candy bar," in paragraphs [0195], [0196], [0197], and [0199], "composite candy bar

with chocolate, nuts and nougat inside," and specifically teaches a myriad of examples of composite material candy bars such as Snickers(tm), Milky Way (tm), Twix (tm), Kit Kat (tm), Kudos (tm), Butterfinger (tm), Baby Ruth (tm), and many others. These candy bars are plainly known to one having ordinary skill in the art to be a composite material candy.

Examiner has failed to show any evidence to the contrary but continues to make the Office Actions final *without any evidence*, which constitutes improper Office Actions. Examiner must consider and respond to the substance of Applicant's argument. As of the present, examiner has not addressed the "substance" of Applicant's arguments and continues to reject the request to amend the specification, as may be permitted in accordance with MPEP 608.01.

Examiner has also failed to respond to Applicant's argument and evidence that examiner had already restricted different flavors of Applicant's "composite material," i.e. composite material candy bar, composite material cookie bar, and composite material granola bar, in the restriction of 5/2/2002, which examiner had taken *directly from original claims 6, 19, 21-23*, where it stated "composite material," (Exhibit A, Election from Exhibit F initial claim 6, claims 19, 21-23, pgs. 1/3-3/3) and therefore "composite material" could not be "new matter."

Applicant's independent claim 6 recited:

6. The edible support of claim 1 wherein said support is a composite material, having a plurality of ingredients, said edible support being suited for a plurality of configurations and orientations, wherein said support is a candy bar, wherein said support is a cookie bar, wherein said support is a granola bar. (Exhibit F, pg. 1/3)

In the first Office Action on the merits on 5/23/2003 (Exhibit H pg. 2/5) examiner states:

"In fact, since the edible support is disclosed as being a composite how can it be homogenous? The two are mutually inconsistent." (underline drawn by examiner)

Examiner also stated 5/23/2003 (Exhibit H pg. 2/5):

In regard to claim 76, claim 76 can be construed to recite that the edible support comprises one or more elements a through m, and particulate matter and a homogenous comestible....

Merriam Webster Online Dictionary:

**mutual:** 1. a : directed by each toward the other, or the others < mutual affection >.

**inconsistent b :** containing incompatible elements

Had Applicant's support been merely an assembly of parts, akin to the support of Firmin (US 1,769,215), i.e. a simple example of a baked stick topped with a chocolate coating, ...a *homogenous* coating could have coated another support part (homogenous baked stick) and one would still be *consistent*, or compatible with the other.

However, Examiner states: "In fact, since the edible support is disclosed as being a composite how can it be homogenous? *The two are mutually inconsistent.*"

N.B. Conclusion: Examiner's argument pertained to a "material" (an assembly of parts are not homogenous, or *of a uniform structure or kind throughout (Merriam Webster 2)*. Thus, Examiner was well aware that Applicant's support comprised "a composite," [noun] i.e. "composite material," "comprising elements a through m..." ("ingredients of," (specification) candy, nuts, fruit, grain, chewing gum...) (Exhibit H, pg. 2/5) (Exhibit I, pg. 3/3, sent by PTO to Applicant, a composite, noun, entry 4. A solid material...) upon the sending of the first Office Action on the merits to Applicant on 5/23/2003, upon which Section 112, first and second paragraphs were satisfied for all independent claims.

**The United States Patent and Trademark Office Had Already Decided That "Edible Composite Support" Had \* Disclosed A "Composite Material" Under 35 USC Section 112, First and Second Paragraphs in The Office Action of 5/23/2003**

N. B. Applicant respectfully submits that it is notably improper for the United States Patent and Trademark Office to had already decided that *all claims* are proper under section 112, first and second paragraphs for the recitation of "edible composite support," as enabled and distinctly claiming a "composite," "a composite material," and then deny all of Applicant's claims for this reason for at least seven years thereafter. (Exhibit H, pg. 2/5, i.e. independent claims 72,87,91,95, "edible composite support," were not objected to, and (Exhibit H, pg. 3/5) no rejections under section 112, second paragraph, Non final Office Action of 5/23/2003) This is unjustified.

In addition, in this same first Office Action on the merits 5/23/2003, ALL of Applicant's independent claims, "which recited, "composite edible support," passed section 35 USC Section 112, first and second paragraphs, were clear to examiner, and were clear to one having ordinary skill in the art that Applicant's support comprised an edible composite material. ([0165], above) Applicants independent claims were claim 72, claim 87, claim 91 and claim 95. Note that section 112, first paragraph of the Office Action rejected only dependent claims 76-81, 89, 94, and 96. (Exhibit H, pg. 2/5 (first arrow) No rejections had been made regarding section 112. No restriction had been made for Applicant's method claims either.

As above, Examiner was well aware of Applicant's "composite material" and decided in this first Office Action on the merits that Applicant's "composite edible support" was in such full, clear and concise and exact terms as to enable any person skilled in the art to which it pertains or with which it is most nearly connected, to make and use the same as well, comprising "a composite



material,” and the claims particularly pointed out and distinctly claimed the subject matter which Applicant regarded as Applicant’s invention.

**N.B. Conclusion:** All of Applicant’s claims of a “composite edible support” had already been decided to be proper in claiming Applicant’s subject matter of a “composite material,” on 5/23/2003, under 35 USC Section 112, first and second paragraphs.

### **Claim Rejection 35 USC Section 112, first paragraph**

**3) Regarding Claim Rejections 35 USC Section 112, (first paragraph), examiner states:**

“In the instant case the term “composite material” changes the description of “a candy bar to “a composite candy bar”, which is not the same as a generic term “candy bar” as originally described. “ ... Therefore the amendments to the claim introduce new matter and the Applicant is required to cancel the new matter in the reply to this Office Action. (Pg. 4 of Final OA)

Examiner has failed to show how “composite material” is new matter. Applicant had argued that it is of the record that the specification recites: “composite candy bar”: in paragraphs [0197][0198] [0200]; (Filed specification (composite candy bar), original claims 6, 19, 21-23, restriction ... etc.) Applicant pointed out that examiner had already made a restriction from an originally filed claim among, a composite material candy bar, a composite material cookie bar, or a composite material granola bar on 5/2/2002. (Exhibit F original claims “composite material” based upon originally filed claims 6, 19, 21-23, and Exhibit A restriction, species IV(a), IV(b), IV(c)). Examiner has not answered Applicant’s argument, nor the substance of it.

Examiner stated: \* “In fact, since the edible support is disclosed as being a composite how can it be homogenous? The two are mutually inconsistent.” (5/23/2003 (Exhibit H, pg. 2) see section 102 below) Examiner not only found Applicant’s composite material to be not be new matter, but to be enabled and to distinctly claim Applicant’s subject matter, under section 112. No rejection had been made.

Examiner has continually failed to respond to Applicant’s argument in the Office Actions, but has systematically rejected all claims, without providing any evidence to the contrary. This constitutes continuing improper Office Actions.

### **Claim Rejection 35 USC Section 112, second paragraph**

**4) Regarding Claim Rejection 35 USC section 112, (second paragraph) indefiniteness for the**

recitation of "a composite material," examiner has not responded to Applicant's argument that the term "composite material" is a well known term, which has been used "as is" in a myriad of issued patents, without definition, such as for example, *issued* US patent to French et al., (6,284,294) filed November 22, 1999 (09/444,969) (filed before Applicant's was filed) which recites the term "composite material" ONLY in the claims (claims 12, 13) and NOT in the specification) and is well known to one having ordinary skill in the art, and therefore there is no requirement for Applicant to explain a well known term. "If elements of an invention are well known in the art, the Applicant does not have to provide a disclosure that describes those elements." MPEP 2106) Applicant had also argued in detail of "composite material" being used as clay bricks with straw embedded in it in ancient times. Examiner has not responded to Applicant's arguments but continues to reject claims 383-402 regardless.

### Claim Rejections - 35 USC Section 102

**The United States Patent and Trademark Office Had Already Decided that Applicant's Support Comprising an Edible "Composite Material" was Enabled, Distinctly Claimed, Novel and Unobvious Over the Reference to Musher as of at Least 5/23/2003**

5) Regarding 35 USC 102(b), claims 383-402 had been rejected as being anticipated by Musher (US 2,217,700).

Although a particular reference to Musher is addressed, Applicant respectfully submits that issues that are other than appealable issues are in question.

In response to the Amendment filed March 16, 2009, the Office mailed a final Office Action on July 9, 2009, which explained that all rejections to claims 383 and 394 were maintained because:

"Regarding claims 383 and 394, Musher teaches ice cream (frozen comestible) on a non-frozen edible support structure or a composite support which has at least two edible discernable (i.e. perceptible) edible confectionary materials or components that are combined together to make the support, i.e., two constituent ingredient materials (Page 1; Column 1, lines 37-46 and Column 2 lines 40-55), as instantly claimed. Also see (page 4: column 1, line 72 to Column 2, line 23 and figures 1-6)." (Final Office Action pages 6-7)

Independent claim 383 recites:

A non frozen support for a frozen comestible comprising an edible confectionary material comprising two ingredient materials within said edible confectionary material or two constituent materials.

Independent claim 394 recites:

A support for a frozen comestible comprising an edible composite material, said edible composite material comprises two ingredient materials within said edible composite material or two constituent materials.

Note that examiner does not address "composite material" but only "composite support." (Applicant found out in a telephone call with Examiner Chawla, that Examiner Chawla has been rejecting all claims under sections 102 and 103 based solely upon a truncated portion of Applicant's claims. Examiner Chawla admitted to rejecting the claims based solely upon Musher's support having "i.e., two constituent materials." Examiner stated that since Applicant's claims were "either/or" claims, that all she had to do was disprove one side of the "or" and that constituted her due diligence. Examiner continues to improperly base all rejections upon a truncated portion of Applicant's claims.

In the specification, Applicant's edible support is recited as "composite support 62," "composite support 62A," etc., and recites examples of composite material candy, cookie and granola. Examiner continues to deny Applicant's claims based upon the term "composite support."

**However:**

**N. B.** It had already been decided by the USPTO that Applicant's "composite support" was enabled, distinctly claimed, novel and unobvious over the reference to Musher as of at least 5/23/2003.

All of Applicant's claims had been cleared with respect to 35 USC Section 112, first and second paragraphs regarding the reference to Musher. It had also already been decided by the USPTO that all of Applicant's claims were novel under 35 USC Section 102 over the reference to Musher, i.e. no rejection for Musher under Section 102 was made in the Office Action; (Exhibit H, pg. 3/5, (5/23/03)). It also had been decided by the USPTO that all of Applicant's *independent* claims (72, 87, 91, and 95) were unobvious over Musher under 35 USC Section 103 (Exhibit H, pg. 4/5) Thus all dependent claims were also a fortiori patentable over Musher. Furthermore, examiner does not argue that Musher comprises a composite material, and therefore examiner agrees that Musher does not comprise a composite material.

Additionally, prior to the final Office Action, Applicant had requested constructive assistance with the claims under MPEP §706.03(d) and §707.07(j), but was denied assistance. Examiner responded:

"It is noted that Applicant has requested help from the examiner. Beside the fact Applicant either has had some experience prosecuting applications or has had experienced help, as evidenced by the fairly accomplished communications, the office provides help or makes suggestions relative to patentability, if the Office has discerned allowable subject matter, As of now, that has not been the case." (Exhibit H, pg. 5/5)

Contrary to what examiner states, Applicant respectfully submits that as of that time "it was the case."

The support of Van Duren (Swiss patent 649197)(cookie) could not make a candy support, (agreed by examiner, i.e. no section 102 rejections), in view of a piece of candy of Laskey (1,566,329), with a filling placed inside, without any suggestion to support a comestible, (agreed by examiner), the combination of which would not comprise a suggestion to be combined to make Applicant's support. (Exhibit M)

No combination could show a composite material, as none of the references themselves comprised or suggested a composite material, or a "composite," (examiner, 5/23/2003), as they each showed only a single material, such as gum (Tezuka et al. 4,399,153) or a support with different parts, such as Van Duren, Laskey, or such as (Jones 1,947,010) with a chocolate coating, or unit structure (Musher 2,217,700).

The reference to Chan (6,177,110) was not prior art of Applicant. (Enabled disclosure document dated as early as 1994).

As far as Applicant is aware, all Applicants, whether pro se or represented, may be provided assistance with the claims. Examiner determined Applicant did not need assistance with the claims *after a single response to the first Office Action on the merits!* Examiner denied Applicant assistance even though Applicant had "patentable subject matter." This is unjustified.

Furthermore, in denying Applicant with assistance, examiner willfully changed the words and meaning of MPEP 707.07(j) from "patentable subject matter" to "allowable subject matter," such that Applicant would have to have the claims allowed before any assistance with the claims would be given to Applicant, (which is of the record as having been improperly delayed for many years), contrary to MPEP §706.03(d) and §707.07(j).

Examiner endlessly and willfully continues to truncate and manipulate Applicant's claims in the Office Actions and then rejects all claims based on examiner's own words and not the words of the claims. Examiner has failed to address Applicant's claims as recited. Examiner has failed to address the heart of Applicant's subject matter. Examiner has failed to address the substance of Applicant's arguments. This is failure of examiner and the PTO and not of Applicant. This activity may be seen throughout the examination, is of the record, and is improperly wasted time by the PTO and not by Applicant.

For example, in the present Office Action examiner removed Applicant's terms "material comprising two ingredient materials" and "composite material" from Applicant's claims 383 and 394 and rejected the claims based upon examiner's own insertion of "composite support." Examiner stated:

"...composite support which has at least two edible discernable (i.e perceptible) edible

confectionary material or components that are combined together to make the support, i.e., two constituent materials... as instantly claimed."

Independent claim 383 recites: A non frozen support for a frozen comestible comprising an edible confectionary material comprising two ingredient materials within said edible confectionary material or two constituent materials.

Independent claim 394 recites: A support for a frozen comestible comprising an edible composite material, said edible composite material comprises two ingredient materials within said edible composite material or two constituent materials.

All of Applicant's considered claims were then rejected and the Office Action was made final based upon this willful and erroneous examination. This is unjustified.

All prior art had been overcome in the response to the Office Action of 3/9/04.

N. B. Applicant submits that since Examiner found no other art to anticipate Applicant's claims, examiner(s) improperly reinstated the reference to Musher again on 10/17/05, (Exhibit J) without any evidence, and fails to answer that Musher does not show a solid material, a material comprising two materials, a composite material, or other arguments, as stated, (even though Applicant's subject matter had already been decided to be enabled, distinctly claimed, novel, and unobvious over Musher on 5/23/2003).

Examiner again rejects all the claims based upon a truncated portion of Applicant's claim:

14. "Musher teaches ice cream on an edible support having at least two discernable edible members wherein one portion extends into the ice cream and one portion extends out of the ice cream for holding. Musher teaches stick that may be completely edible."

Applicant's independent claim 179 recited:

A supported frozen comestible comprising:

- (a) a supported frozen comestible, and
- (b) a composite candy support having two discernable edible members in contact with each other suitable for supporting said frozen comestible, said two discernable members each being other than an edible coating said composite candy support having a first portion extending into said frozen comestible, said first portion having sufficient surface area and means for adherence within said frozen comestible to support said comestible, said composite candy support having a second portion having a second portion extending outside said frozen comestible, said second portion having sufficient surface area to provide a utilitarian support for said comestible.

Even though Applicant's subject matter had already been determined by the PTO to be both novel and unobvious over the reference to Musher (Exhibit H, pgs. 3/5-4/5, 5/23/03), the

reference to Musher is continuing to be willingly and unjustly used under sections 35 USC 102, and 103 based upon examiner's own words and truncated portions of Applicant's claims, a procedure admitted to by Examiner Jyoti Chawla on the telephone on January 29, 2010, to deny Applicant's claims from being allowed.

No prior art has been found under 35 USC Sections 102 or 103, ("A person shall be entitled to a patent unless -") yet examiner(s) continue to unfairly reject all claims, without any factual evidence. Examiner(s) continue to fill Office Actions with non-compliant double-talk that does not answer the substance of Applicant's arguments, and promptly issues a final rejection after Applicant has paid for an impartial and fair examination (RCEs to keep the application alive). These responses are of the record, are in violation of the MPEP, (700 Examination) are respectfully submitted to be clearly unfair, and unjustifiable.

Examiner stated, "further a composite is defined as "made of separate elements",

"Reference V" was sent to Applicant by this same Examiner Jyoti Chawla. Reference V, pages from the Merriam Webster Dictionary which defined a "composite" [noun] as:

"a solid material made of two or more substances having different physical characteristics and in which each substance retains its identity while contributing desirable properties to the whole; esp a structural material made of plastic within which a fibrous material (as silicone carbide) is embedded."

Applicant argued that the dictionary recited "a composite" [noun] as a "solid material." Examiner has not addressed Applicant's argument.

Applicant had further argued that the patent to Musher was comprised of interstices or voids to hold ice cream within the structure, the reason for the invention.

Applicant argued that Musher did not comprise a "composite material," as according to the PTO dictionary definition sent to applicant from Examiner Chawla, a composite material was a solid material and Musher's unit structure was filled with interstices and therefore could not be a composite material. Applicant argued that Musher taught away from using a composite material, as the interstices were needed to hold his ice cream. (Exhibit K, pg. 1/3 - 3/3)

N.B. Examiner rejected all of the examined claims and made the Office Action final without addressing any of these arguments.

Applicant also argued the reference to Musher does not anticipate Applicant's claims as the supported confection of Musher is frozen and therefore Applicant's claims are not anticipated. Applicant's support is not frozen. Applicant noted that Examiner had stated that:

"The formed and coated support of Musher is non-frozen prior to addition of liquid and

freezing steps. Thus the composite support for a frozen confection as taught by Musher is not frozen until the ice cream material is poured into the voids and the entire structure is frozen." (Exhibit K, pg. 2/3)

Applicant brought up the fact that examiner agrees with Applicant that Musher's support is "entirely frozen."

Examiner still rejected all claims without responding to Applicant's argument and made the Office Action final. This is unjustified and constitutes an improper Office Action.

**N. B.** Applicant respectfully submits that it is notably improper for the United States Patent and Trademark Office to have already decided that *all independent claims, and thus all dependent claims* were both novel and unobvious over the reference to Musher on 5/23/2003, and to continue to use the reference to Musher against the claims without any evidence of a material comprising two materials, or an edible composite material, and to retain these groundless rejections for over seven years.

As above, Applicant respectfully submits that the finality of the Office Action is further noted to be improper, [emphasis added] as Examiner has continually failed to acknowledge Applicant's subject matter in years of Office Actions, although it is of the record that Examiner is well aware of Applicant's subject matter, having cleared the subject matter under section 112, in 2003.

#### **Telephone Conversation Regarding the Final Office Action**

**N.B.** Note that as of the conversation on January 29, 2010, regarding the above final Office Action, Examiner Jyoti Chawla stated that all Examiner Chawla had to do was disprove one side of the "or" in Applicant's claim which constituted examiner's due diligence. On January 29<sup>th</sup>, 2010, Examiner Chawla admitted to addressing only a truncated part of Applicant's claims for maintaining the rejections of all examined claims. Examiner's rejection was based solely upon, Musher teaching "i.e. two constituent materials," and thus admitted to sending an improper final Office Action to Applicant. (Exhibit L, Applicant's summary of telephone conversation with Examiner Jyoti Chawla re: final Office Action of 7/09/2009, pg. 4/4).

Examining only a portion of a claim is improper examining procedure and hence Applicant respectfully submits that the outstanding Office Action is therefore improper.

(TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM) MPEP 2131 Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v.*

Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

**Reference to Feybusch:**

The Office Action also failed to address how Applicant's argument of how the structure of Feybusch (US 1,638,4880) is not a solid or a composite material, as it requires crevices to drain melting ice cream away from a user's hand when it is being eaten.

The Office Action also failed to address Applicant's argument of how the structure of Feybusch does not show a material that comprises two materials, as each of the materials of Feybusch shows only raw ingredients.

The reference to Feybusch was mailed to Applicant 4/30/2008, nearly eight years after Applicant's filed application, does not show a composite material, or a material comprising two materials, shows no new features for rejections under 35 USC sections 102 or 103, and is submitted to be non-compliant with compact prosecution, and improper.

**Reference to Lane:**

In the final Office Action, dependent claim 391 was rejected under 35 USC 103(a) as being unpatentable over Feybusch in view of Lane et al. (US 1,690,984).

**Claim 350 recited:**

The support for a frozen comestible of claim 383 wherein one of said two constituent materials comprises an edible hollow confection length, wherein the other of said two constituent materials comprises an edible filling placed in said hollow length, wherein said filling comprises a plurality of candy beads, colored sugar, flavored sugar, an edible confection rope, or a fluid ingredient, said two ingredient materials comprise two ingredient materials placed concentrically.

Claim 350 (391) had been previously presented for examination in dependent claim 350 on 7/30/2008. Claim 350 could have been rejected in an earlier Office Action but was not. (Exhibit L, Lane)

Section 706.07(a) of the MPEP specifies the conditions under which the finality of a second or subsequent Office Action is proper, providing that:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by Applicant's amendment of the claims nor based on information submitted in an information disclosure statement....



Thus, Applicant respectfully submits that because claim 350 (391) was previously presented for examination in a preceding Office Action, the new ground of rejection of claim 391 made in the final Office Action is improper.

Introducing a new reference to Lane *after ten years* is also noted to be improper under the rules of compact prosecution. MPEP Section 707.07(g)

**N. B.** Applicant asked Examiner on the telephone why the claims were being rejected by Musher without any evidence. Examiner Chawla said that she was not making a section 102 rejection, but a section 103 rejection. When Applicant asked again to clarify the situation, "so you are not making a section 102 rejection?" Examiner Chawla chose not to answer. (Exhibit L, pg. 4/4, bottom arrow)

Applicant respectfully submits that the finality of the most recent Office Action and previous Office Actions have been improper for at least the willful detainment of Applicant's application without evidence of anticipation under 35 USC Section 102, unobviousness under 35 USC Section 103, unsubstantiated rejections under Section 112, first and second paragraphs, willful and express truncating of Applicant's claims to maintain the rejection of all claims, the withholding of Applicant's method claims from consideration without argument or evidence, maintaining rejections without evidence, continual failure to address applicant's claims as recited, failure to consider the "heart" of Applicant's subject matter, which is documented to have been known by examiner at least as of the first Office Action on the merits, failure to address the substance of applicant's arguments, and failure to adhere and abide by the rules and regulations of the MPEP.

Applicant respectfully submits that new groundless rejections are being made throughout the application, even though Applicant's claims are respectfully submitted to be enabled, novel and non-obvious over all cited art.

### **Conclusion**

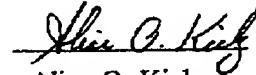
The conditions at least as set forth in § 706.07(a) of the MPEP; MPEP 707.07(f) and at least for all the above stated reasons, have not been satisfied.

In view of the foregoing, Applicants respectfully requests withdrawal of the finality of the outstanding Office Action of 7/9/2009 and thus the withdrawal of the holding of abandonment for the above application. Applicants also respectfully requests that Applicant's method claims be properly reinstated and considered, and further requests that a new non-final Office Action that specifically addresses each of the foregoing arguments be sent to Applicant. Accordingly, as well

Appn. Number 09/641,410 (Kiely) GAU 1794 Petition to Director to Withdraw Holding of Abandonment 18

as in the interests of fairness Applicant respectfully requests that the finality of the final Office Action and thus abandonment of the application be withdrawn.

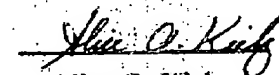
Very Respectfully,

  
Alice O. Kiely

71 Stonewall Court  
Yorktown Heights, NY 10598  
Tel. (914) 960-3506

Certificate of Facsimile: I certify that on the date below, this document and referenced attachments, if any, will be faxed to the central fax number of 571-273-8300 to the United States Patent and Trademark Office "Commissioner for Patents" Arlington, Virginia 22313.

2010 March 27,

  
Alice O. Kiely

Attached:

Exhibit A - 3 pages  
Exhibit B - 1 page  
Exhibit C - 4 pages  
Exhibit D - 1 page  
Exhibit E - 1 page  
Exhibit F - 3 pages  
Exhibit G - 3 pages  
Exhibit H - 5 pages  
Exhibit I - 3 pages dictionary  
Exhibit J - 1 page  
Exhibit K - 3 pages  
Exhibit L - 4 pages  
Exhibit M - 1 page

Exhibit A

09/641,410

GAV 1794

A.KIELY

pg. 1/3

(5/2/02)

Application/Control Number: 09/641,410

Page 2

Art Unit: 1762

This application contains a myriad number of species or inventions (depending on how one looks at them) and the follow restriction/election is made.

This application contains claims directed to the following patentably distinct species of the

claimed invention: Species I, wherein the comestible is frozen

Species II, wherein the comestible is non-frozen

In addition, beside electing Species I and II, the following election of support is required :

Species III wherein the support is malleable

Species IV wherein the support is non-malleable

Depending on which species ~~is~~<sup>is</sup> of support elected, If the non-malleable species is elected, a further election is required between:

Species IVa, wherein the support is a candy bar

Species IVb, wherein the support is a cookie bar

Species IVc, wherein the support is a granola bar

It is noted that two species/inventions of support ingredients are recited (i.e. claims 25&26). Presumably, they are mutually exclusive and are associated with either Species III or IV.

Thus, wherein the support is:

Species x, dextrose, malt dextrine, etc.

Species y, marshmallow

Species z, licorice

In addition, and, again presumably as a function of the type of confection (i.e. non-frozen or frozen), applicant is required to elect one of the following:

Exhibit A

09/641,410

GAV 1794

A. KIELY

Pg. 2/3

Application/Control Number: 09/641,410

Page 3

Art Unit: 1762

Species a, wherein the supported comestible rocks

Species b, wherein the supported comestible rolls

Species c, wherein the supported comestible spins

Species d, wherein the supported comestible twists

Species e, wherein the supported comestible whistles

Species f, wherein the supported comestible hangs

Species g, wherein the supported comestible pierces

Species h, wherein the supported comestible stands upright

Species i, wherein the supported comestible invertible

Species j, wherein in the supported comestible is wearable

As noted above, although these are referred to as "species" of supported comestible, they could also be considered separate inventions. However, the affect is the same in terms of a restriction requirement.

The claims also recite various species of additional "fun" ingredients and election is required between:

Species aa, wherein the ingredient is flavor

Species bb, wherein the ingredient is a decoration

Species cc, wherein the ingredient is prize

Currently, no claim is generic.

The claims are also restrictable between Invention I, the supported comestible as claimed in claims 1-16.

Invention II, the kit as claimed in claim 17.

Exhibit A

09/641,410

GAU 1794

A. KIELY

p9 3/3

Application/Control Number: 09/641,410

Page 4

Art Unit: 1762

Invention III, the mold and packaging apparatus

These inventions are separate and distinct. The supported comestible can be made without the specific kit Group II and it does not have to be made and combined with the elements of Group III. The inventions of Group II and III are two distinct, unrelated inventions. Also, the kit of Group II would not be associated with the product of Group I. It could be used to make the product of Group I.

To expedite prosecution, it is noted that the application was filed without a claim 29. Therefore, claim 30 is renumbered claim 29.

Also, the specification and drawings are replete with inconsistencies in numbering and lettering.

For example, the ingredients are not arranged concentrically in Fig. 33 as is stated on page 33 of the specification and in figure 2 the support is shown as "62" rather than "62a" as is noted on page 33. There are many more errors of this type. Applicant should carefully review all 98 pages of the specification, as well as the nineteen sheets of drawings, for similar problems.

The remainder of the references cited on the USPTO form are cited as art of interest.

Any inquiry concerning this communication or from the examiner should be directed to Steven Weinstein whose telephone number is 703-308-0650. The examiner can generally be reached on Monday-Friday 7:00am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone numbers for the organization where this application is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Exhibit B

1/1

(12/17/02)

09/641,410

GAU 1794

A. KIELY

Application/Control Number: 09/641,410

Page 2

Art Unit: 1714

For the record, applicant has not specifically addressed the election of species set forth in the Office action mailed 5/2/02, paper no. 7. Ordinarily, applicant is required to elect one or more species. There is no statement that an election was not made since the amendment presents a group of claims to which the election is no longer relevant. However, this does seem to be the case.

In view of the presentation of the new set of claims in the amendment filed 6/5/02, paper no. 8, the election in paper no. 7 is withdrawn in favor of the following new election:

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I, wherein the comestible has a support as shown e.g. in Fig 1, or

Species II, wherein the comestible has a plurality of supports as shown e.g. in Fig 35-39,

and

Further, election is also required between

Species III, wherein the support is a composite support, as shown e.g. in Fig 1, or

Species IV, wherein the support is a homogeneous support as shown e.g. in Fig 3

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Exhibit

C

07/641,410

GAU 1794

A. KIELY

Monday, March 16, 2009 7:26 PM

Alice Kiely 914 245-6661

p.17

App# Number 09/641,410 (Kiely)

GAU 1794

Response to Advisory Action 16

maximum flavor and taste, or provide a long lasting second dessert with an already familiar taste for the consumer.

[0184] Support 64 is shown with composite ingredients as in support 62, but it can also be made as support 60, 70.

One skilled in the art is well aware that the materials that make up well known composite candy bars are constituent materials. No new matter has been introduced. The term "constituent" has already been examined in previous office actions by examiner for Applicant's invention. What is already in front of one is not new and does not need further examination. Under the fundamental principal of 35 U.S.C. 112, second paragraph, and according to MPEP 2173.01, Applicant is permitted to use alternative language... to define the subject matter of Applicant's claims.; *In re Swinehart* "Reasonable clarity" (MPEP \* 2163.02). "the components of the term have well recognized meanings..." 2173.02 Clarity and Precision [R-3]

Applicant's term "constituent" has well recognized meaning and satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, and is therefore permitted.

(However, if the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, *the claim must not be rejected under 35 U.S.C. 112, second paragraph*, rather, the examiner should suggest improved language to the applicant.)

#### Regarding Election/Restriction

→ No restriction had been made regarding method claims for the above application. Please see correspondence of January 16, 2009 which is documented as being on file.

#### Claim rejections 35 USC Section 112 first and second paragraphs

Please see correspondence of January 16, 2009 which is documented as being on file, and as such

App. Number 090641,410 (Kiely)

GAU:1794

Response to Office Action

15

Exhibit C

## Remarks General

p. 2/4

## Regarding Election/Restriction



Claims 403-416 are said to be rejected as being independent or distinct from the invention elected in response filed January 18, 2003.

The record shows that NO restriction of a product vs. method had been required in any Office Action for the above application. As far as Applicant is aware, choosing a species does not preclude one from including a method claim(s) if it is not independent or distinct from the elected species. See for example: 35 USC Section 101; 35 USC Section 112(6). As for the present instant rejection, Examiner has made no attempt to say how these claims are independent or distinct from Applicant's "examined" claims, as required, and therefore the rejection is improper for at least this reason.

Applicant cannot properly respond to this allegation. (MPEP 706.07(a))

Examiner's restriction is improper. MPEP 808.02. Applicant therefore respectfully requests withdrawal of the objection and reconsideration and allowance of the method claims.



## Regarding Amendments to Specification:

The proposed amendments to the specification have been objected to under 35 USC 132(a) as said to introduce new matter into the disclosure. The added material which is said to not be supported by the original disclosure is as follows: the addition of "composite material" which is said to change the description from "a candy bar" to "a composite material candy bar" which is not the same as a generic term "candy bar" as originally described.

Applicant respectfully disagrees that the terminology "composite material" in the requested amendment is new matter. The term "composite material" is disclosed in original claims 6, 19-23,



Appo. Number 09/641,410 (Kiely)

GAU 1794

Response to Office Action

15

Exhibit C

## Remarks General

p7. 3/4 ✓ Applicant respectfully requests withdrawal of the finality of the Office Action, since it is noted to be improper.

**The Finality of the Office Action is Improper**

Examiner expects to impose unjustified rejections *without any factual evidence*.

Examiner has also introduced a new reference to Lane US 1,690,984) and hence the finality of the Office Action is improper.

It is of the record that examiner has at least:

- 1). Not made a prima facie case of a "non-elected invention" (burden of examiner) i.e. has not articulated an alternative method to Applicant's method claims 403-416 as being patently distinct (see MPEP § 707.07(f)).
- 2). Not made a prima facie case of new matter for amendments to specification (burden of examiner) when Applicant had claimed "a composite material," as originally filed in claims 6, 19, 20, 21, 22, and 23, or enablement with regard to page 2: 35 USC 132(a) and 35 USC section 112, first paragraph, other than a generic MPEP paragraph stated rejection, which is not a sufficient or a valid reason (see 35 USC 132(a)).
- 4). Not made a prima facie case of anticipation (burden of examiner) over the known merits of Applicant's claims with regard to the reference to Musher (2,217,700) (1939). This includes, but is not limited to, "Reference V" sent by Examiner Jyoti Chwla to Applicant (Merriam Webster 3 pages, attached) where the PTO says a "composite material" is a "~~solid material~~" and the unit structure of Musher is anything but solid, (i.e. filed with interstices for ice cream) and,

As such, Applicant cannot properly respond to these allegations. Thus the finality of the Office Action is improper. (MPEP ' 706.07(a); MPEP 808.02. Accordingly, Applicant's amendments to the claims are therefore proper. Applicant is entitled to a means claim(s) section 112 (6) and method claims, below, unless proven otherwise by examiner. Examiner has not proven otherwise. Applicant therefore respectfully requests reconsideration and removal of the Final Office Action.

**Regarding Election/Restriction**

Claims 403-416 are said to be rejected as being independent or distinct from the invention elected in response filed January 18, 2003.

On page 3 of Advisory Action, continuation of 11, examiner states:

"Applicants' argument that examiners' withdrawal of method claims 403-416 for being directed to an invention other than elected invention is incorrect as method claims were not present at the time of the election and the election was made between the species of products (remarks 17-19) is not persuasive."

In response, as far as Applicant is aware, the election of a species does not preclude an applicant from the right to a method(s) and/or a means claim(s). 35 USC Section 101; 35 USC Section 112(6). Examiner has the burden to prove that Applicant's method claims are patently distinct. Examiner *has not stated any reason* why Examiner has rejected the method claims as being patentably distinct. Examiner has not made a showing of distinctness between the method of making or using the product and the product, *as required*. Thus the restriction cannot be required. As below.

A rejection of the method claims solely for the reason of "election was made between the species of products" is not conclusive or valid.

Additionally, method claims need not be present at the time of any election, contrary to the merits of examiner's argument. 821.04(b), as below. Furthermore, the record shows that Applicant had originally filed a method of making a support *prior to* any office action, restriction requirement, or election. See original method claim 28 filed August 18, 2000. (See 821.04(b) below.) Barring a prima facie case of patentable distinction from Examiner, all of Applicant's claims are proper unless proven otherwise. MPEP § 806.05(i); MPEP § 806.05(f); MPEP § 806.05(h). Applicant therefore respectfully requests reconsideration and reinstatement of Applicant's claims 403-416.

Exhibit D

09/641,410 GAU 1794 A. KIELY

8/18/2000

pg. 1/1

106

utilitarian support for said body, said malleable support being suited for a plurality of configurations and orientations.

- 28. A method of providing a supported comestible comprising:
- (a) providing a body of an edible substance,
  - (b) providing an edible support, having first and second portions, for supporting said body,
  - (c) inserting said first portion of said edible support, into said body, supporting said body, and
  - (d) providing a second portion, having sufficient size outside of said body to provide a utilitarian support for said body.
- 30. The method of providing a supported comestible of claim 28, further including an edible, moisture-proof, coating on said edible support and said body.
- cont.*
- 10 6 4 1 0*

Exhibit E

09/641,410

GAU 1794

A. KIELY

1/28/10

1/1

Continuation Sheet (PTO-303)

Application No. 09/641,410

Continuation of 3. NOTE: The applicant is advised to read MPEP 714.12 and 714.13. In particular "Once a final rejection that is not premature has been entered in an application, applicant or patent owner no longer has any right to unrestricted further prosecution. This does not mean that no further amendment or argument will be considered. Any amendment that will place the application either in condition for allowance or in better form for appeal may be entered. Also, amendments complying with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR 1.116(b). Ordinarily, amendments filed after the final action are not entered unless approved by the examiner." Applicant is also advised to read 706.07, which concerns Final Office Actions, and discourages Applicants from switching from subject matter to subject matter, as done by Applicant from the Original Claims to the Amended Claims.

Applicant has amended the claims 383-399, 401-403, 405-408, 410, 412-414, 416, cancelled claims 400 and added one new claims 417. Claims 383-416 which were pending in the final office action dated July 9, 2009 have been amended. Amendment to claims 383-416 and addition of a new claim filed November 23, 2009 have not been entered as it raises new issues of search and consideration and also regarding new matter and indefiniteness.

Following are some of the examples of issues raised by the amendment:

1) For example, independent claims 383 and 403, have been amended from: "A non frozen support for a frozen comestible comprising an edible confectionary material comprising two ingredient materials within said edible confectionery material or two constituent ingredient materials" to "A support for a frozen comestible comprising an edible material, said edible material comprises two materials". The new amendment changes the scope of the invention as the support materials need not be confectionary materials, as examined in the final office action dated July 9, 2009. Further, ingredient materials as examined in the final office action of 7/9/2009 are not the same as confectionery material comprising two materials.

2) For example, dependent claim 389 has been amended from "support comprises single component" to include two materials chosen from a list: "two materials comprise two mixed materials, two layered materials, two twisted materials, two swirled materials, two materials placed together, two attached materials, two materials placed concentrically, parallel or diagonally, two materials placed in a combination of directions...one of said two materials filled with the other of said two materials, one of said two materials wrapped with the other of said two materials, or a combination thereof." which changes the scope of the invention as claimed. There are several other similar issues in the newly amended claims that would require further search and/or consideration.

Continuation of 11. does NOT place the application in condition for allowance because:

Applicants' argument that examiners' withdrawal of method claims 403-416 for being directed to an invention other than elected invention is incorrect as method claims were not present at the time of the election and the election was made between the species of products (Remarks, pages 17-19) is not persuasive. Claims directed to product. Currently amended and newly submitted claims 406-417 are directed to a method of making a support, i.e., an invention that is independent or distinct from the invention elected in response filed January 18, 2003 to the original restriction requirement.

Since the applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation on the merits. Accordingly amended claims 405-416 and new claims 417-418 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Applicant's other remarks submitted 11/23/09 are in regards to the newly added amendments, which have not been entered. Thus, the arguments are moot and the rejections are maintained for reasons of record.

Continuation of 13. Other: The amendment to specification filed 11/23/09 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the addition of "a composite material" in paragraphs [0043], [0044], [0164], [0166] which was not disclosed in the specification as originally filed and has also been added to claims. The term "a composite material" as disclosed in the amendment would introduce new matter and change the description from "a candy bar" to "a composite material candy bar" in paragraph [0164], which is not the same as a generic term "candy bar" as originally described. Therefore, the amendments to the specification introduce new matter and the applicant is required to cancel the new matter in the reply to this Office action.

Amendment to paragraph [0171] in reference to item 100 in figure (27 E), it is noted that there is no item 100 labeled in Figure 27 E. Amendment to paragraph [0197] correcting the typographical error will be entered if submitted separately as has been indicated in the final rejection dated July 9, 2009.

Exhibit F

09/641,410 GAU 1794 A.KIELY

pg. 1/3

100

supported comestible is non-frozen.

→ 6.

The edible support of claim 1 wherein said support is a composite material, having a plurality of ingredients, said edible support being suited for a plurality of configurations and orientations, wherein said support is a candy bar, wherein said support is a cookie bar, wherein said support is a granola bar.

7. The edible support of claim 1 wherein said support has homogeneous ingredients, said support being suited for a plurality of configurations and orientations, wherein said support has the ingredients comprising: dextrose, maltodextrin, citric acid, magnesium stearate, and flavoring, wherein said support is made of marshmallow.
8. The edible support of claim 1 wherein said support is malleable, said malleable support being suited for a plurality of orientations and configurations, wherein said support is made of licorice.
9. The supported comestible of claim 1 wherein said

Exhibit F

09/641,410 GAU 1794

A. KIELY

pg. 2/3

103

comprising: a mold, a plurality of tools, a plurality of ingredients, a set of instructions, a plurality of appendages, said mold, tools, ingredients, instructions, and appendages, being suited to construct a predetermined supported comestible, said comestible kit being suited to construct frozen and non-frozen supported comestibles.

18. The supported comestible of claim of 1, further including a combined mold and protective packaging apparatus, for manufacture of said supported comestible, wherein said apparatus has an aligning device for aligning said support.

19. A supported comestible comprising:

(a) a body of an edible substance, and

(b) an edible support suitable for supporting said body,

→ wherein said support is a composite material, having a plurality of ingredients, said edible support having a first portion extending into said body, said first portion having sufficient surface area within said body, to support said body, said edible support having a second portion extending outside said body, said second

09/641,410 GAV 1794

A. KIELY

Exhibit F

pg 3/3

104

portion having sufficient size to provide a utilitarian support for said body, said support being suited for a plurality of configurations and orientations.

20. The supported comestible of claim 1 wherein said second portion has sufficient size so that a person can hold said body and said edible support with a hand.

→ (21) The supported comestible of claim of (19) wherein said support is a candy bar.

→ (22) The supported comestible of claim of (19) wherein said support is a cookie bar.

→ (23) The supported comestible of claim of (19) wherein said support is granola bar.

24. A supported comestible comprising:

- (a) a body of an edible substance, and
- (b) an edible support suitable for supporting said body, wherein said support has homogeneous ingredients, said edible support having a first portion extending into said body, said first portion having sufficient surface

09/641,410

GAU 1794

A. KIELY

JAN-16-2009 07:04P FROM:DANIEL KIELY 9142456661

TO:15712738300

P:16/23

Appn Number 09/641,410 (Kiely)

GAU 1794

Amendment A

15

Exhibit G

## Remarks - General

pg 1/3

Applicant submits that all claims clearly define novel and unobvious subject matter over each and every reference and any combination thereof.

## Amendments to Specification

Examiner stated that the amendment filed July 30, 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the addition of "composite material" in paragraphs [0043] [0044] and [0166], which was not disclosed in the specification as originally filed and has also been added to claims. The term "a composite material" as disclosed in the amendment would introduce new matter and change the description from "a candy bar" to "a composite material candy bar" in paragraph [0164] which is not the same as a generic term "candy bar" as originally described. Therefore, the amendments to the specification introduce new matter and the applicant is required to cancel the new matter in the reply to this Office Action.

See 608.01(I) Original Claims In establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims if their content justifies it.

Where subject matter not shown in the drawing or described in the description is claimed in the application as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and requirement made to amend the drawing and description to show this subject matter. The claim should not be attacked either by objection or rejection because this subject matter is lacking in the drawing and description. It is the drawing and description that are defective, not the claim.

In response, as said in previous responses to office actions, correcting the specification to reflect what is in the original claims, as filed, is NOT introduction of new matter.

Applicant's original disclosure August 18, 2000, illustrated and recited, "a composite material."

The mere mention that "composite material" changes the description from a "candy bar" to a



JAN-16-2009 07:04P FROM: DANIEL KIELY 9142456661

09/641,410

GAU 1794 A. KIELY

TO: 15712738300

P: 17/23

Exhibit G

Appn. Number 09/641,410 (Kiely)

GAU 1794

Amendment A

16

pg. 2/3

"composite material candy bar" is not sufficient for a prima facie case of rejection under 35 USC 132(a), and is moot. Applicant's original claims 6, 19-23 recite: "wherein said support comprises a composite material." Drawings, the terms "composite support 62, 62A... Milky Way Bar, Snickers Bar, etc.," "composite candy bar" throughout the specification, and PTO date stamped disclosure documents 1994, 1996, 1999 showing and testing of composite material candy bars, is direct and factual evidence of a support comprising "a composite material." Examiner has failed to satisfy its burden to articulate a prima facie case. Without adequate evidence of the basis of this rejection, the burden to rebut this rejection with evidence and/or argument has not yet shifted to Applicant. Applicant has evidence in the original claims and in the specification. Examiner does not show sufficient evidence to the contrary.

N.B. Reading the specification shows a "composite material candy bar:"

[0195] A list of some suitable supports, are as follows:

[0196] composite candy bar with caramel, whipped chocolate nougat which is dipped in chocolate

[0197] composite candy bar with an elongated cookie stick, with caramel on top of the caramel, which is then dipped in chocolate

[0199] composite candy bar with chocolate, nuts and nougat inside

See MPEP section 2164. "Furthermore, when the subject matter is not in the specification portion of the application as filed but is in the claims, the limitation in and of itself may enable one skilled in the art to make and use the claim containing the limitation. When claimed subject matter is only presented in the claims and not in the specification portion of the application, *the specification should be objected to for lacking the requisite support for the claimed subject matter using Form Paragraph 7.44.* See MPEP § 2163.06. This is an objection to the specification only and enablement issues should be treated separately." 2163.06: "The claims as filed in the original specification are part of the disclosure and therefore, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter."

Examiner thus admits that the terms "composite support 62," and "composite support 62A..." is interchangeable, or one in the same, for the term "composite material support 62, 62A..." or otherwise would have asked for a correction of the specification in the first office action in view of original claims 6, 19-23, and all the recitations of composite support 62 and "composite candy

PAGE 17/23 \* RCVD AT 1/16/2009 6:50:30 PM [Eastern Standard Time] \* SVR:USPTO-EFXXF-4/39 \* DNIS:2738300 \* CSID:9142456661 \* DURATION (mm:ss):07:08

09/641,410

GAU 1794

A. KIELY

JAN-16-2009 07:05P FROM: DANIEL KIELY 9142456661

TO: 15712738300

P: 18/23

Exhibit 6

Appn. Number 09/641,410 (Kiely)

GAU 1794

Amendment A

17

pg. 3/3

bar comprising the ingredients of caramel, whipped nougat," etc. See: [0195, 0196, 0199] above, i.e. material not components, and replete with descriptions of composite support Snickers Bar, Milky Way Bar, Baby Ruth Bar throughout the specification, as above. These candy bars are known to one skilled in the art, and notably to an examiner in the required field, to comprise a "composite material." MPEP section 2164 recites: "When claimed subject matter is only presented in the claims and not in the specification portion of the application, the specification should be objected to for lacking the requisite support for the claimed subject matter using Form Paragraph 7.44." Examiner had NOT objected to the specification, and thus concurred. (see also 2111 Claim Interpretation i.e. *consistent with* the specification) The evidence is overwhelming that Examiner(s) were well aware that applicant was claiming a composite material. Examiners did not object to name brand composite candy bars found in a grocery store in the specification. Examiner did not object to the specification in view of all claims that recited "a composite support" in the independent claims and only added components in the dependent claims such as "a composite support... *further including a mess guard, a drip guard, a lollipop.*" Having all claims written as such, examiner had failed to fulfill its burden to identify the support of the application, and having made no requirement for applicant to change the wording of the specification "composite support 62, 62A..." thus understood the meaning of composite support to mean composite material support, such as Milky Way, Snickers, etc. Examiner is required to have come to understand the claims before the first office action.

↑  
MPEP Examination

The term "bar" is a single component. As known to one skilled in the art, a "composite candy bar" is a composite material. As above, Examiner's argument claiming "new matter" is moot. Without adequate evidence of the basis of this rejection, the burden to rebut this rejection with evidence and/or argument has not yet shifted to Applicant. Examiner does not have sufficient evidence to the contrary.

Applicant therefore respectfully requests reconsideration and allowance of the amendments to the specification.

PAGE 18/23 \* RCVD AT 1/16/2009 6:50:30 PM [Eastern Standard Time] \* SVR:USPTO-EF/RP-6/39 \* DNIS:2738300 \* CSID:9142456661 \* DURATION (mm:ss):07:08

Exhibit H

09/641,410 CAU 1794 A. KIELY

MAR 29 2010

P1-  
1/6

## Office Action Summary

Application No.

09/641,410

Applicant(s)

KIELY

Examiner

S. WEINSTEIN

Group Art Unit

1761

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.135(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

☒ Responsive to communication(s) filed on 1/23/03☐ This action is FINAL.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 72-98 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 72-98 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))
- \*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-848
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

U.S. Patent and Trademark Office  
PTO-325 (Rev. 11/00)Part of Paper No. 11

\*U.S. GPO: 2000-472-939/43204

EXHIBIT H

09/641,410 GAU 1794

A. KIELY

pg 2/5

Application/Control Number: 09/641,410

Page 2

FOAM

Art Unit: 1761

5/23/03

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

→ Claims 76-81, 89, 90, 94 and 96 are rejected under 35 USC 112, first paragraph for being based on a non-enabling disclosure.

In regard to claim 76, claim 76 can be construed to recite that the edible support comprises one or more elements a through m, and particulate matter and a homogenous comestible. The claim is based on a non-enabling disclosure, since it is not seen that the specification supports one or more of elements a through m as well as having particulate matter and be homogenous. In fact, since the edible support is disclosed as being a composite, how can it be homogenous? The two are mutually inconsistent. Clarification and/or correction of the claim language is requested. That is, if the particulate matter and homogenous comestible are additional to the support, the claims should reflect this. For purposes of examination, since applicant has not defined composite edible support, this phrase will be construed to mean any two materials in contact with each other. Claim 77 recites that the additional confection provides a "lollipop configuration". Neither claim nor the specification is clear as to what this means. Claim 79 recites that the supported comestible includes means for inhibiting the breakage of the edible support. As disclosed, it is not clear what is this "means for inhibiting breakage". Similarly in claim 80 for the phrase means for providing a supported comestible "designed for a child". How would this supported comestible differ from any other? What makes the comestible "designed for a child"? Claim 81 shares a

Exhibit H

09/641,410 GAU 1794

pg 3/5

Application/Control Number: 09/641,410  
Art Unit: 1761

Page 3

similar problem as that of claim 76. That is, if one construes claim 81 as the barrier having all the properties of elements a-e as well as additional properties of the second a and b, where is this supported in the specification? If these are alternative expressions of characteristics, the claim should be amended to make this concept clearer.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 72-76, 87, 88, 91, 95 and 98 are rejected under 35 U.S.C. 102(b) as being anticipated by Ref. N (Swiss 649197).

Ref. N discloses a supported comestible comprising a comestible comprising a body of an edible substance and a substantially composite edible support capable of supporting the comestible wherein the edible support replaces the conventional wood ("bois") or plastic ("plastique") sticks used to support frozen confections. Thus, since the composite edible support replaces the conventional ice cream sticks, it would inherently have a first portion in the comestible and a second portion outside the comestible for hand held support. Thus, contrary to what has been urged, Ref. N not only teaches edible support sticks are conventional, but also teaches composite edible sticks are conventional as well. In regard to claim 74, Ref. N discloses that the support has good mechanical resistance and is thus inherently "substantially" non-malleable. In regard to claim 76, as noted above, the wording and thus the intent of claim 76 is unclear. If one construes all of the elements in the alternative, then Ref. N discloses

Exhibit H

09/641,410 GAV 1794 A. KIELY

pg. 45

Application/Control Number: 09/641,410

Page 4

Art Unit: 1761

→ sugar as an ingredient of the edible support. In regard to the method claim 95, since Ref. N discloses the composite edible sticks replace the conventional wooden sticks, Ref. N inherently teaches adding the stick to the comestible before freezing which is how the wooden sticks are added to the confection since after freezing, the addition of the stick would be difficult or impossible.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

→ Claims 76-79, 86, 93 and 97 rejected under 35 U.S.C. 103(a) as being unpatentable over Ref. N in view of Musher (2,217,700).

If one construes claim 76 to recite one of the elements a through m and a particulate and a homogenous comestible, then Musher can be relied on to teach the conventionality of edible supports (36), additional edible homogenous material (35) and particulate material (10). Once it is known to provide edible and even edible composite supports, the particular conventional additional materials one chooses to add is seen to have been an obvious matter of choice and one of personal taste and to modify, Ref. N would therefore have been obvious. In regard to claim 77, although it is not clear what a "lollipop configuration" means, as noted above, Firmin teaches a support stick plus additional confection and to modify Ref. N, for its art recognized and applicants intended function would have been obvious. The particular conventional additional confection (i.e., chewing gum), would have been an obvious matter of choice and personal

Exhibit H

09/641,410

GAV 1794

A. KIELY

Application/Control Number: 09/641,410  
Art Unit: 1761

Page 5

p9.  
5/5

conventionality of edible sleeves or jackets. To modify the combination and provide a moveable, edible sleeve for its art recognized and applicant's intended function would therefore have been obvious.

Applicants arguments filed August 20, 2003 have been considered but are moot in view of the new grounds of rejection necessitated by the amendment.

It is noted that applicant has requested help from the examiner. Beside the fact applicant either has had some experience prosecuting applications or has had experienced help, as evidenced by the fairly accomplished communications, the Office provides help or makes suggestions relative to patentability, if the Office has discerned allowable subject matter. As of now, that has not been the case.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Ref. V. 09/641,410

Exhibit I

pg. 1/3



09/641,410 GAU 1794 A. KIELY-JOK

# Merriam- Webster's Collegiate<sup>®</sup> Dictionary

## TENTH EDITION

Merriam-Webster, Incorporated  
Springfield, Massachusetts, U.S.A.



Exhibit I

pg. 2/3

09/641,410 GAU 1794 A. KIELY - JOK



## A GENUINE MERRIAM-WEBSTER

The name *Webster* alone is no guarantee of excellence. It is used by a number of publishers and may serve mainly to mislead an unwary buyer.

*Merriam-Webster*™ is the name you should look for when you consider the purchase of dictionaries or other fine reference books. It carries the reputation of a company that has been publishing since 1831 and is your assurance of quality and authority.

Copyright © 1997 by Merriam-Webster, Incorporated

Philippines Copyright 1997 by Merriam-Webster, Incorporated

Library of Congress Cataloging in Publication Data  
Main entry under title:

Merriam-Webster's collegiate dictionary. — 10th ed.  
p. cm.

Includes index.

ISBN 0-87779-708-0 (unindexed : alk. paper). — ISBN 0-87779-709-9 (indexed :  
alk. paper). — ISBN 0-87779-710-2 (deluxe : alk. paper). — ISBN 0-87779-707-2  
(laminated cover).

1. English language—Dictionaries. I. Merriam-Webster, Inc.

PE1628.M36 1997  
423—dc20

96-42529  
CIP

Merriam-Webster's Collegiate® Dictionary, Tenth Edition principal copyright 1993

COLLEGIATE is a registered trademark of Merriam-Webster, Incorporated

All rights reserved. No part of this book covered by the copyrights hereon may be reproduced or copied in any form or by any means—graphic, electronic, or mechanical, including photocopying, taping, or information storage and retrieval systems—without written permission of the publisher.

Made in the United States of America

1920RMcn97



09/641,410 GAV 1794 A. KIELY

Exhibit J

Application/Control Number: 09/641,410

Page 6

pg. 1/1

Art Unit: 1761

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 179-182, 184-187, 189-198 are rejected under 35 U.S.C. 102(b) as being anticipated by Musher (US 2217700).

NO  
VALID  
ARGUMENT

14. Musher teaches ice cream on an edible support having at least two discernable edible members wherein one portion extends into the ice cream and one portion extends out of the ice cream for holding. Musher teaches stick, which may be completely edible (Page 5, Column 2, lines 46-56). The end of the stick may include a lollipop that is also connected structure pieces (Page 5, Column 1, lines 54-65), which may include items such as nuts or even a plurality of candy pieces (Page 3, Column 2, lines 14-21 and Page 5, Column 2, lines 24-35), and the lollipop and structure pieces may be coated in hard fat, which would prevent the transfer of moisture and improve the adhesion or grip of the frozen comestible (Page 5, Column 1, lines 65-Column 2, line 2). Musher further teaches the structure pieces around the lollipop, which include candy, can be placed concentrically (i.e. a circle around the lollipop) to improve support, or maneuvered in some other manner on the support (Page 5, Column 1, lines 45-54 and Column 2, lines 24-35). Furthermore, Musher teaches a plurality of voids in the overall structure (i.e. note the spaces in Figure 6 between the structure pieces and lollipop).

(Also See Page 6, Column 1, lines 4-70, Page 2, Column 2, line 64 to Page 3, Column 1, line 60 and Figures).

Exhibit K

09/641,410 GAU 1794 A. KIELY

pg. 1/3

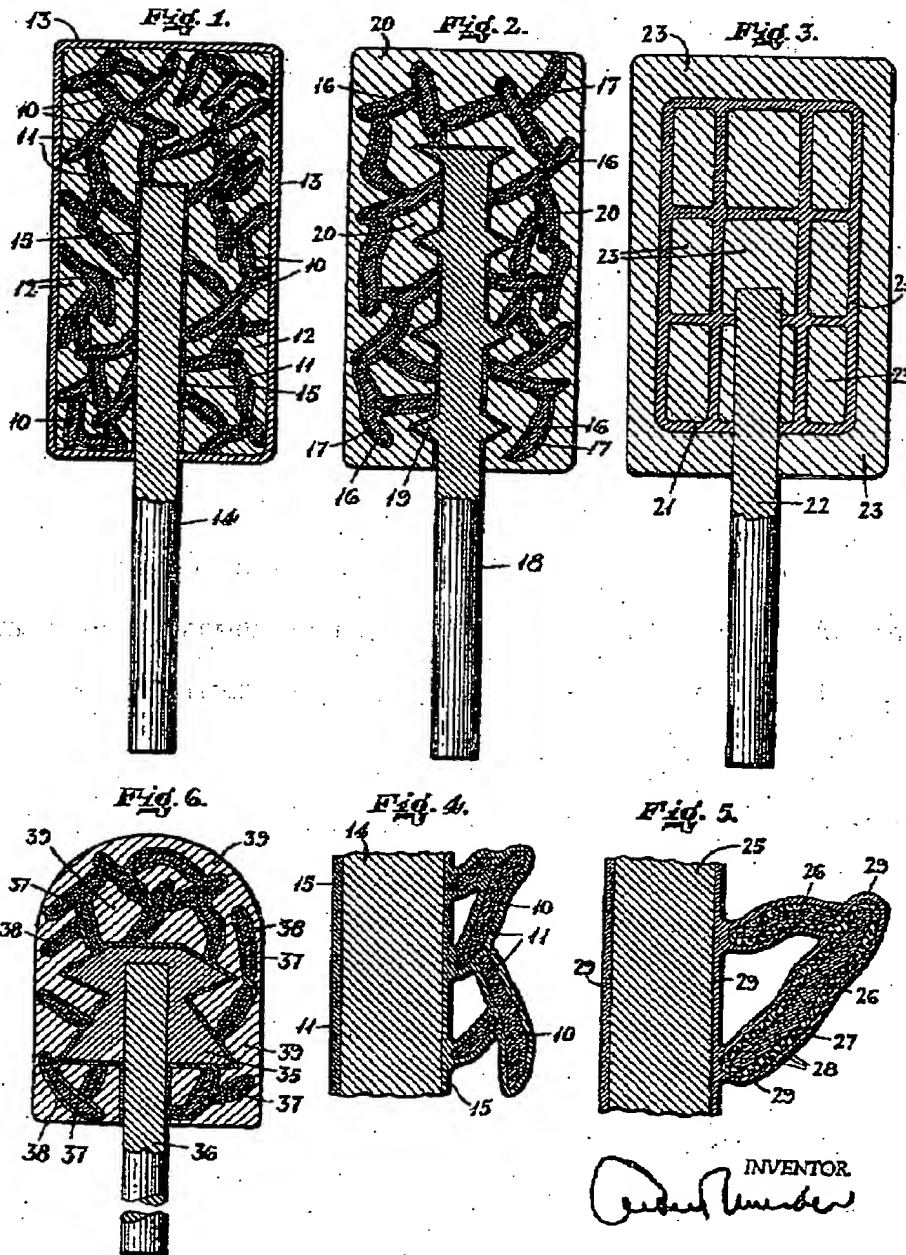
Oct. 15, 1940.

A. MUSER

2,217,700

FROZEN CONFECTION AND METHOD FOR MAKING IT

Filed July 1, 1939



09/641,410

GAU 1794

A. KIELY

JAN-16-2009 07:39P FROM:DANIEL KIELY 9142456661

TO:15712738300

P:13/22

Exhibit K

Appn. Number 09/641,410 (Kiely)

GAU 1794

Amendment A

34

pg. 2/3

been anticipated by Musher.

In the past Office Action examiner has rejected the claims asserting that the "the formed and coated support of Musher is non-frozen prior to addition of liquid and freezing steps. Thus the composite support for a frozen confection as taught by Musher is not frozen until the ice cream material is poured into the voids and the entire structure is frozen."

In response, it is noted that Examiner has thus admitted, that the support of Musher is *frozen* upon completion of the invention. ("...until the ice cream material is poured into the voids and the entire structure is frozen.") Examiner may not dissect Musher's invention and use an incomplete invention to reject Applicant's claims. This is unjustified and unlawful. This method would undermine countless issued patents. Examiner, as well, may not ignore the teachings of the invention as a whole, i.e. a frozen confection. To be anticipated, an invention as a whole must be fully considered. Musher's invention shows a frozen confection. Applicant's invention, above, is a non-frozen invention comprising a non frozen material that comprises two non frozen ingredient materials. Musher's invention is an edible assembly which does not show evidence of a composite material. Musher has not disclosed every element of applicant's claim(s). Therefore, Musher has NOT anticipated Applicant's claims, since to be anticipated, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Thus far examiner has not shown any factual evidence of non-patentability, as required. This omission amounts to a failure to articulate a prima facie case of unpatentability and the burden to rebut this "rejection" has not yet shifted to Applicant. (See MPEP § 706.07(a); and 2106 Patent Subject Matter Eligibility [R-6] USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered.)

#### Musher Teaches Away From a Composite Material

A composite, or composite material, is known by those skilled in the art of making materials to have a solid material. Therefore, Musher, in addition to not anticipating applicant's claims for at

JAN-16-2009 07:40P FROM:DANIEL KIELY 9142456661

09/641,410

GAU 1794

A. KIELY

TO:15712738300

P:14/22

Exhibit K

Pg. 3/3

Appn Number 09/641,410 (Kiely)

GAU 1794

Amendment A

35

least the reasons above, also does not show a composite material, as his framework cannot comprise a solid material and his stick and fat each show only one ingredient material, i.e. baked stick, chocolate. Musher teaches away from using a composite material. (See Britannica below). The material that makes Musher's framework must be an edible lacy or lattice material with many "interstices" to hold ice cream within it. (page 2, col. 2, lls. 28-32) (page 3, col. 1, lls. 75 - col. 2, lls. 1-13) (all drawing figures, all *embodiments*). "provide as much space as possible for the predominant, base material..." (Pg. 4, col 1, lls. 26-43). Musher's framework I can *never* be a solid material.

Britannica online encyclopedia article on composite material: construction - also called *composite*: a solid material that results when two or more different substances, each with its own characteristics, are combined to create a new substance whose properties are *superior* to those of the original components in a specific application. *The term composite more specifically refers to a structural material*, (such as plastic) within which a fibrous material (such as a silicone carbide) is embedded.

#### Definition of the word Bar

1. a relatively long, evenly shaped piece of some solid substance, as metal or wood, used as a guard or obstruction or for some mechanical purpose: the bars of a cage.
2. an oblong piece of any solid material: a bar of soap; a candy bar.

See also class definition 426/89, above for solid material.

If Musher's unit framework were a solid material, ice cream could not flow into it for the purpose of Musher's invention, i.e. supporting the ice cream within the framework, and would be inoperative. A solid material does not work for Musher. There would be no voids for the ice cream to flow into if the material were solid. Musher teaches directly away from using a composite material in his support. Musher's baked stick is a single ingredient material, baked stick, one ingredient material, not two, and does not comprise a composite material. Musher's inventive step did not include the use of a composite material. The combination of the framework with the baked stick, as well, is not a composite material, since at least the unit framework is at right angles to the baked stick, i.e. is not a solid material, does not have a common interface, and are separate materials anyway, which is not disputed.

PAGE 14/15 \* RCVD AT 1/16/2009 7:27:17 PM [Eastern Standard Time] \* SVR:USPTO-EFXRF-4/13 \* DNIS:2738300 \* CSID:9142456661 \* DURATION (mm:ss):18-08

Mar 27 10 05:27p

Alice Kiely

914 245-6661

p.48

Feb 23 10 02:44p

Alice Kiely

09/641,410

GAU 1794

914 245-6661

A. KIELY

p.2

RECEIVED  
CENTRAL FAX CENTER

FEB 23 2010

Exhibit L

pg. 1/4

*In the United States Patent and Trademark Office*

Appn. Number: 09/641,410  
Appn. Filed: August 18, 2000  
Applicant: Alice Mary O'Donnell Kiely  
Title: Edible Supports for Comestibles with Optional, Edible Mess Guards and Drip Guards  
Examiner/GAU: Chawla/Hendricks/1794

Yorktown Heights, NY February 23, 2010

**Applicant's Summary of Telephone Conversation**

Assistant Commissioner for Patents  
Arlington, Virginia 22313

Sir:

The following is Applicant's summary of the phone call with Jyoti Chawla on January 29, 2010 with respect to the above application.

Feb 23 10 02:44p

Alice Kiely

09/641,410 GAV 1794

A. KIELY

914 245-6661

p.3

Exhibit L

pg. 2/4

Appn Number 09/641,410 (Kiely)

GAU 1794

Telephone Summary

2

On 1/29/10 Examiner Jyoti Chawla called Applicant. Applicant received the voice mail from Examiner Chawla and called Examiner Chawla back.

When Applicant called back, Applicant got a prerecorded message made by Examiner Chawla. Applicant left a message saying that Applicant was returning her phone call.

Examiner Chawla called back and said that she had been on the other line with someone.

#### Background:

With regard to Application 09/641,410 Edible Supports for Comestibles, Applicant had made two responses to the Final Office Action of 7/09/2009. One on 10/09/09 (20 pages) and the other on 11/23/2009 (25 pages). As always, Applicant responded to every concern of Examiner. Applicant's two responses also pointed out that the finality of the Final Office Action was improper. Examiner had improperly made the Office Action Final having failed to show any factual evidence of anticipation under 35 USC section 102, or any factual evidence of obviousness under 35 USC section 103 with regard to the reference to Musher (2,217,700) over the merits of Applicant's claims. Therefore the Office Action may not be made final.

Applicant's two responses also noted that the finality of the Office Action was improper for the further reason that Examiner specifically failed to address Applicant's argument that the unit structure of Musher did not show a solid material and therefore did not show a composite material. Examiner neither "took note of Applicant's argument nor addressed the substance of it." MPEP 707.07(f) If an examiner does not respond to an applicant's argument, an applicant is unable to respond to the allegations and the Office Action therefore may not be made final.

In Applicant's two responses, Applicant further pointed out that the finality of the Office Action was improper for furthermore having introduced a new prior art reference to Lane (1,690,984) in the Final Rejection. This new reference was to find obvious a claim that had been present prior to a non-final office action. Specifically claim 350 recited on 7/30/2008 was present *before* the non-final office action of 10/16/2008 was sent. The *feature(s)* in claim 350 could have been rejected in an earlier office action but were not, i.e. was not necessitated by Applicant's amendment 706.07(a), and therefore the Office Action may not be made final. Applicant's two responses were sent in plenty of time for Examiner Chawla to reconsider the finality of the Office Action.

Applicant is concerned [emphasis added] that Examiner(s) continue to improperly make Office Actions final:

- a) while failing to address the \*known subject matter of Applicant's claims as a whole, i.e. examiners are unlawfully dissecting the claims and rejecting the claims based upon these dissections taken out of context;
- b) without responding to the merits of Applicant's arguments, i.e. examiners are unlawfully taking the words of Applicant's arguments out of context;
- c) while failing to "take note of nor address the substance of..." at least Applicant's specific



Feb 23 10 02:45p

Alice Kiely

09/641,410

GAU 1794

914 245-6661

A. KIELY

p.5

Exhibit L

pg. 3/4

Appa Number 09/641,410 (Kiely)

GAU 1794

Telephone Summary

4

(Thus, Examiners had been making unjustified section 102 rejections against Applicant with regard to the reference to Musher for nearly 7 years.)

At approximately midpoint in the conversation, Examiner Chawla asked, what application are we discussing?

Before the end of the conversation, Examiner Chawla said to Applicant, "maybe you should get an attorney."

Feb. 23 10 02:45p

Alice Kiely

09/641,410 GAU 1794

A. KIELY  
914 245-6661

p.4

Exhibit L

pg. 4/4

Appa Number 09/641,410 (Kiely)

GAU 1794

Telephone Summary

3

argument that a composite material is a solid material, while the unit structure of Musher is filled with interstices for ice cream and does not show a solid material or a composite material;  
d) without presenting any factual evidence of anticipation under 35 USC section 102, or obviousness under 35 USC section 103 for the reference to Musher, or  
e) while introducing a new reference to Lane (1,690,984) while the noted claim was present prior to a non-final office action.

(\*Examiners are well aware of the subject matter of Applicant's support from responses from Applicant to Examiner's restriction.)

#### Telephone Discussion:

→ Examiner Chawla told Applicant that the application was going to be abandoned. Applicant told Examiner Chawla that application 09/641,410 had not been abandoned. When I asked Examiner Chawla why she wasn't addressing my claims, Examiner Chawla said that she had been addressing my claims and that since my claims were "either/or" claims, all that she had to do was to disclaim one side of the "or" in the claims and that constituted her due diligence.

(Examiner has thus admitted to dissecting Applicant's claim and making the Office Action Final based on this dissected claim portion taken out of context. Examiner's had made the rejection final based on a false and unlawful misinterpretation of Applicant's claims which thus has precluded the office from considering the merits of Applicant's independent claims, as well as Applicant's patentability arguments prior to the final rejection.)

↓ Applicant asked Examiner Chawla why the Office Action had been made final when a new reference to Lane (1,690,984) had been introduced for the first time in the Final Office Action. Applicant brought to the attention of Examiner during the conversation that claim 350 had already been present prior to a non-final office action and Examiner had the opportunity to bring up the reference to Lane earlier.

Examiner Chawla responded that it didn't matter that the noted claim had been present in an earlier Office Action but that she could introduce a new reference and make that Office Action Final because a change in the status modifier gave her the right to do so.

↑ (Examiner could have rejected the features of claim 350 in a prior office action but failed to do so.)

→ Applicant had asked why all claims were constantly being rejected under section 102 as being anticipated by Musher (2,217,700) without any evidence that anticipated the merits of Applicant's claims. Examiner Chawla said that she wasn't making a section 102 rejection, but only a section 103. When Applicant asked again, "So you are not making a section 102 rejection?" Examiner Chawla chose not to answer.

Exhibit M

09/641,410

GAU 1794

A. KIELY

Application/Control Number: 09/641,410

Page 2

Art Unit: 1761

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 99-103, 105, 107, 108, 109, 113, 119-121, 122, 125-127, 129, 130-133, 135 and 136 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Dueren (Swiss 649,197) in view of Chan (6,177,110) and Laskey (1,566,329) further in view of Tezuka et al (4,399,153), Firmin (1,769,215), Jones (1,947,010) and Musher (2,217,700).

In regard to claim 99, Van Dueren, as noted in the last Office action, mailed May 23, 2003, discloses a frozen comestible comprising a body of an edible substance and a composite edible support of two materials. Claim 99 now recites that the support is a composite candy support. As evidenced by Chan, it was conventional in the art to employ candy as a handle to support a food material to be eaten like lollipops and frozen confections on sticks. Chan discloses that his edible candy support stick can be a composite including, for example, a main candy shaft and candy particles embedded therein. Laskey, although not disclosing a composite as a support, nevertheless is further evidence of edible candy composites. To modify Van Dueren and substitute one conventional edible composite for another conventional edible composite for its art recognized and applicant's intended function would therefore have been obvious. Tezuka et al, Firmin, Jones and Musher are relied on as further evidence of edible supports for frozen confections. Tezuka et al, for example, employs a support formed from chewing gum. Firmin discloses a candy stick with cocoa butter coating. Jones discloses a candy